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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/513,845	02/25/2000	Henry Haugland	53548-014	7424

27975 7590 10/03/2007

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EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 10/03/2007

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

MAILED

OCT 02 2007

Technology Center 2100

Application Number: 09/513,845
Filing Date: February 25, 2000
Appellant(s): HAUGLAND ET AL.

David L. Stewart
Reg. No. 37,578
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed April 24, 2007 appealing from the Office action mailed January 24, 2006.

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(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement that no amendments have been filed subsequent to the Final rejection of January 24, 2006 is correct. However, the persecution was re-opened and a Requirement for Restriction/Election was sent on July 27, 2007. In view of the telephone interview between the Appellant's representative and the TC2100 director on August 2, 2007, the restriction requirement is vacated.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

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The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,793,972	Shane	8-1998
6,009,410	LeMole et al.	12-1999

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 45-53 and 62-63 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

To be statutory, a claimed computer-related process must either: (A) result in a physical transformation outside the computer for which a practical application is either disclosed in the specification or would have been known to a skilled artisan, or (B) be limited to a practical application with useful, concrete and tangible result.

In view of Applicant's disclosure, specification page 18, line 10, the "computer readable medium" is not limited to tangible embodiments, instead being defined as including both tangible embodiments (e.g., RAM, ROM, CD-ROM, disks, etc.) and intangible embodiments (e.g., carrier waves). These claims are not patent eligible because it lacks necessary physical articles or objects to constitute a machine or a manufacture within the meaning of 35 U.S.C 101.

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It is clearly not a series of steps or acts to be a process nor is it a combination of chemical compounds to be a composition of matter. As such, these claims fail to fall within a statutory category. It is, at best, functional description material per se.

Claims 1-5, 7-12, 17, 23, 25, 27-28, 31-33, 42-43, 45-48, 51-53, and 62-63 are rejected under 35 U.S.C. 103(a) as being obvious over Shane et al. (U.S. Patent No. 5,752,022 hereinafter Shane).

In considering claims 1, 8, 31, 46, 48, and 51, Shane discloses a method for inducing a contact to invoke a resource prepared by a promoter on a network, the method comprising:

generating a resource location description for the resource by the promoter, the resource location description including a personal identification code of the contact (figures 2 and 3; col. 4, lines 9-16; col. 5, lines 1-10);

providing access to the resource at a location on the network according to the resource location description (figures 2 and 3; col. 4, lines 20-32) and;

notifying the contact about the resource location description for the resource (col. 4, lines 16-19).

Although Shane does not explicitly teach including the name of the contact in the resource location description as claimed, he teaches the ability to retrieve the name of the contact thru the use of the personal identification code of the contact (figures 2 and 3; col. 4, lines 9-16; col. 5, lines 1-10). The personal identification code in this case, represents the name of the contact. By accessing the personal identification code, the name of the contact is displayed in a

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personalized page. The identification code in a resource locator description ensures confidentiality for those that do not wish for their names to be exposed in the World Wide Web. The claim would have been obvious because the substitution of a contact name for a personal identification would have yielded predictable results to one of ordinary skill in the art at the time of the invention.

In considering claim 2, Shane discloses tailoring content in the resource in response to the resource location description used to access the resource (col. 2, lines 65-67 through col. 3, 1-3).

In considering claim 3, Shane discloses providing access to the resource at the location comprising placing the resource at the location (col. 5, lines 8-20).

In considering claim 4, Shane discloses an operating system to divert a request for the resource at the location to a second location where the resource resides (see fig. 4B, 116, 118).

In considering claim 5, Shane discloses a method wherein a request for the resource includes the resource location description; and the method further comprises generating content for the document dynamically in response to the resource location description in the request (col. 5, lines 21-35).

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In considering claim 7 and 47, Shane discloses setting up a contact database; and automatically retrieving the contact name from the contact database before the generating the resource location description (col. 2, lines 55-60).

In considering claim 9, Shane discloses wherein the resource location description is a universal resource locator address (col. 2, lines 28-39).

In considering claim 10, Shane discloses wherein the resource location description includes a directory name (figure 2: 54); and the generating comprises the personal identification code in the directory name (col. 4, lines 10-16 and col. 5, lines 50-56). Although Shane does not explicitly teach including the name of the contact in the resource location description as claimed, he teaches the ability to retrieve the name of the contact thru the use of the personal identification code of the contact (figures 2 and 3; col. 4, lines 9-16; col. 5, lines 1-10). The personal identification code in this case, represents the name of the contact. By accessing the personal identification code, the name of the contact is displayed in a personalized page. The identification code in a resource locator description ensures confidentiality for those that do not wish for their names to be exposed in the World Wide Web. The claim would have been obvious because the substitution of a contact name for a personal identification would have yielded predictable results to one of ordinary skill in the art at the time of the invention.

In considering claim 11, Shane teaches wherein: the resource location description includes a host name (figure 2: 54); and said generating comprises using the personal

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identification code in the host name. Although Shane does not explicitly teach including the name of the contact in the resource location description as claimed, he teaches the ability to retrieve the name of the contact thru the use of the personal identification code of the contact (figures 2 and 3; col. 4, lines 9-16; col. 5, lines 1-10). The personal identification code in this case, represents the name of the contact. By accessing the personal identification code, the name of the contact is displayed in a personalized page. The identification code in a resource locator description ensures confidentiality for those that do not wish for their names to be exposed in the World Wide Web. The claim would have been obvious because the substitution of a contact name for a personal identification would have yielded predictable results to one of ordinary skill in the art at the time of the invention.

In considering claim 12, Shane discloses making a resource location description unique among a plurality of other resource location description corresponding to a plurality of contacts (Col. 6, lines 15-20).

In considering claim 17, Shane discloses updating a domain file name to include the host name for use by the domain name server (col. 5, lines 46-56).

In considering claim 23, Shane discloses the generating further comprising making a subdomain name in the resource location description unique among a plurality of other document location descriptions corresponding to the plurality of contacts and sharing a common higher level domain name (col. 4, lines 9-11 and col. 5, lines 51-62; see also fig.2).

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In considering claim 25, Shane discloses the tailoring further comprising including information associated with the contact in a contact database into the content of the resources (Col. 4, line 44-50).

In considering claim 27, Shane discloses denying access to the resource if a request for a resource does not include a predetermined authentication (col. 4, 56-65).

In considering claim 28, Shane discloses dynamically tailoring content in the resource in response to authentication in a request for the resource (col. 4, lines 56-65).

In considering claims 32 and 52, Shane discloses the step of configuring further comprises treating requests as visits to a persistent web site belonging to the contact (col. 6, lines 29-35 and col. 7, lines 45-49).

In considering claims 33 and 53, Shane discloses the method further comprises receiving content for the persistent web site from the contact; and the step of configuring further comprises presenting content from the contact in response to the request (col. 4, lines 44-50 and col. 5, lines 4-7).

In considering claim 42, Shane discloses a method of promoting a cause to a contact, the method comprising:

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including a personal identification code in a network address associated with the cause (figures 2 and 3; col. 4, lines 9-16; col. 5, lines 1-10);

including the network address in material sent to the contact (figures 2 and 3; col. 4, lines 20-32) and

broadcasting the networks address to a plurality of targets (col. 4, lines 6-19 and Fig 3).

Although Shane does not explicitly teach including the name of the contact in the resource location description as claimed, he teaches the ability to retrieve the name of the contact thru the use of the personal identification code of the contact (figures 2 and 3; col. 4, lines 9-16; col. 5, lines 1-10). The personal identification code in this case, represents the name of the contact. One of ordinary skill in the art would recognize that by accessing the personal identification code, the name of the contact is displayed. The claim would have been obvious because the substitution of a personal identification code for the contact name would have yielded predictable results to one of ordinary skill in the art at the time of the invention.

In considering claims 43 and 63, Shane discloses a method and a computer program product of conducting a promotion, comprising:

including personal identification code in a network address associated with the promotion (figures 2 and 3; col. 4, lines 9-16; col. 5, lines 1-10); and

broadcasting the networks address to a plurality of targets (col. 4, lines 6-19 and Fig 3).

Although Shane does not explicitly teach including a name of the promotion in the resource location description as claimed, he teaches the ability to retrieve the promotion thru the use of the personal identification code of the contact included in the resource location description

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(figures 2 and 3; col. 4, lines 9-16; col. 5, lines 1-10). When the resource location description is accessed, it takes the user to a personalized page that includes the name of the contact as well as the promotion. The claim would have been obvious because the substitution of a name of the promotion for a personal identification code would have yielded predictable results to one of ordinary skill in the art at the time of the invention.

In considering claim 45, Shane teaches a computer-readable medium bearing promotion information for use by one or more processors that are participating in providing resource on a network, the promotion information comprising:

contact information about a contact to receive materials as part of a promotion (figures 2 and 3; col. 4, lines 9-16; col. 5, lines 1-10); and

a resource location description indicating where the resource can be accessed on the network, the resource location information including information from the contact information (figures 2 and 3; col. 4, lines 20-32).

Claims 6, 13-16, 18-22, 24, 26, 29-30, and 49-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shane in view of LeMole (U.S. Patent No. 6,009,410 hereinafter LeMole).

In considering claims 6 and 26, although Shane discloses the system substantially as claimed Shane does not disclose the method comprising logging activity involving the resource, and changing content in response to the activity logged. Nonetheless logging activity and

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changing the content in response to the logged activity is well known. In similar art LeMole discloses wherein user activity about a resource is logged and an advertising page is created based on the user's profile stored in the user profile database (col. 4, lines 47-56). Thus given the teaching of LeMole, a person having ordinary skill in the art would have recognized the advantages and desirability of modifying the system as disclosed by Shane to include the step of logging activity involving the resource; and changing content in response to the activity logged in order to provide customized pages to the user. Therefore the claimed limitation would have been obvious modifications.

In considering claims 13-16, 24 and 49 while the combined system of Shane and LeMole discloses the system substantially as claimed it does not explicitly disclose making the resource location description unique by making changes to the characters and domain.

Shane teaches generating a personal identification code for the contact name. By definition, a personal identification code is unique to every user. The claim would have been obvious because the substitution of a contact name for a personal identification would have yielded predictable results to one of ordinary skill in the art at the time of the invention.

Nonetheless, Examiner takes official notice that making changes to the characters or domain to make a URL unique is well known in the art. It would have been obvious to a person having ordinary skill in the art to make the resource location description unique by modifying the characters and the domain in order to ensure that the variety of promotions are recipient specific thus ensuring creativity in the targeted advertising. Therefore the claimed limitations would have been obvious modification to the combined system of Shane and LeMole.

In considering claim 18-22 and 50, while the combined system of Shane and LeMole discloses the system substantially as claimed it does not explicitly disclose terminating access to the resource at the location when a promotion ends or reaches a predetermined stage.

Nonetheless Examiner takes official notice that the aforementioned limitations are well known features of Internet advertisements.

It would have been obvious to include the steps of terminating access to the resource at the location when a promotion ends or reaches a predetermined stage in order to allow the user to have access to a variety of promotions that are available. Therefore the claimed limitations would have been obvious modification to the combined system of Shane and LeMole.

In considering claims 29 and 30, although the combined system of Shane and LeMole discloses the invention substantially as claimed it does not disclose launching a credit card purchase process in response to activity logged and directing user acting on a document to a secure socket layer. Nonetheless Examiner takes official notice that the aforementioned limitations are well known features of e-commerce sites. It would have been obvious to include the steps into the combined system of Shane and LeMole in order to provide the user with purchasing capabilities on visited sites.

(10) Response to Argument

Appellant's arguments have been considered but not found persuasive.

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Response to issue 1: Appellant's argument that the Examiner erred in rejecting claims 1-5, 7-12, 17, 23, 25, 27-28, 31-33, 42-43, 45-48, 51-53 and 62-63 under 35 U.S.C. 103(a) as being obvious over Shane.

In view of Supreme Court Decision in *KRS International Co. v. Teleflex Inc.*, 550 U.S. -, 82 USPQ2d 11385 (2007), the Supreme Court stated that the Federal Circuit erred when it applied the well-known teaching-suggestion-motivation (TSM) test in an overly rigid and formalistic way. According to the Supreme Court, the TSM test is one of a number of valid rationales that could be used to determine obviousness. It is ***not*** the only rationale that may be relied upon to support a conclusion of obviousness.

In response to Appellant's argument that the Shane reference does not utilize the name of a contact in a URL, and there is no teaching or suggestion in Shane to utilize the name of the contact as part of a URL, the PTO respectfully submits that this is obvious over Shane.

Although Shane does not explicitly teach including the name of the contact in the resource location description as claimed, he teaches the ability to retrieve the name of the contact thru the use of the personal identification code of the contact (figures 2 and 3; col. 4, lines 9-16; col. 5, lines 1-10). The personal identification code in this case, represents the name of the contact. By accessing the personal identification code, the name of the contact is displayed in a personalized page. The identification code in a resource locator description ensures confidentiality for those that do not wish for their names to be exposed in the World Wide Web. The claim would have been obvious because the substitution of a contact name for a personal

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identification would have yielded predictable results to one of ordinary skill in the art at the time of the invention.

In response to Appellant's argument that Shane does not teach that the URL includes the "name of the promotion" in a network address as required by claims 43 and 64, the PTO respectfully submits that this is obvious over Shane. Although Shane does not explicitly teach including a name of the promotion in the resource location description as claimed, he teaches the ability to retrieve the promotion thru the use of the personal identification code of the contact included in the resource location description (figures 2 and 3; col. 4, lines 9-16; col. 5, lines 1-10). When the resource location description is accessed, it takes the user to a personalized page that includes the name of the contact as well as the promotion. The claim would have been obvious because the substitution of a name of the promotion for a personal identification code would have yielded predictable results to one of ordinary skill in the art at the time of the invention.

In response to Appellant's argument that Shane does not disclose a computer readable medium that has the information from the contact information included in the location information described in claim 45, the PTO respectfully disagrees and submits that Shane teaches this feature. Figure 2: 54 and 56 illustrates a location information (54) that includes a personal identification code (56). Since Applicant fails to specifically define "information from the contact information" and "location information," these elements are broadly interpreted as location information 54 including a personal identification code 56, respectively.

In considering claim 10, Shane discloses wherein the resource location description includes a directory name (figure 2: 54); and the generating comprises the personal identification

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code in the directory name (col. 4, lines 10-16 and col. 5, lines 50-56). Although Shane does not explicitly teach including the name of the contact in the resource location description as claimed, he teaches the ability to retrieve the name of the contact thru the use of the personal identification code of the contact (figures 2 and 3; col. 4, lines 9-16; col. 5, lines 1-10). The personal identification code in this case, represents the name of the contact. By accessing the personal identification code, the name of the contact is displayed in a personalized page. The identification code in a resource locator description ensures confidentiality for those that do not wish for their names to be exposed in the World Wide Web. The claim would have been obvious because the substitution of a contact name for a personal identification would have yielded predictable results to one of ordinary skill in the art at the time of the invention.

In considering claim 11, Shane teaches wherein: the resource location description includes a host name (figure 2: 54); and said generating comprises using the personal identification code in the host name. Although Shane does not explicitly teach including the name of the contact in the resource location description as claimed, he teaches the ability to retrieve the name of the contact thru the use of the personal identification code of the contact (figures 2 and 3; col. 4, lines 9-16; col. 5, lines 1-10). The personal identification code in this case, represents the name of the contact. By accessing the personal identification code, the name of the contact is displayed in a personalized page. The identification code in a resource locator description ensures confidentiality for those that do not wish for their names to be exposed in the World Wide Web. The claim would have been obvious because the substitution of a contact name for a personal identification would have yielded predictable results to one of ordinary skill in the art at the time of the invention.

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In considering claim 12, Shane discloses making a resource location description unique among a plurality of other resource location description corresponding to a plurality of contacts (col. 6, lines 15-20). Shane discloses including a personal identification code in a URL. By definition, a personal identification code is unique to each user.

In considering claim 23, Shane discloses the generating further comprising making a subdomain name in the resource location description unique among a plurality of other document location descriptions corresponding to the plurality of contacts and sharing a common higher level domain name (col. 4, lines 9-11 and col. 5, lines 51-62; see also fig.2). Shane discloses including a personal identification code in a URL. By definition, a personal identification code is unique to each user.

Response to issue 2: Appellant's argument that the Examiner erred in rejecting claims 6, 13, 16, 18, 22, 24, 26, 29-30 and 49-50 under 35 U.S.C. 103(a) as being obvious over Shane in view of LeMole.

On October 14, 2005, Applicant filed a Declaration under 37 C.F.R. 1.132, the use of the contact's name results in unexpectedly superior returns in response to a direct contact initiative such as direct mailing. However, the declaration was not considered valid because while it compares the use of the contact's name in a URL to direct mailing, it does not compare the use of contact's name in a URL with a personal identification code in a URL. There is no evidence that the use of the contact's name in a URL is superior to the use of a personal identification

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disclosed by Shane. At col. 2, line 1, Shane too claimed that his use of personal identification is superior to direct mailing.

With respect to dependent claims 14-15, 18-20 and 49, while the combined system of Shane and LeMole discloses the system substantially as claimed it does not explicitly disclose discloses making the resource location description unique by making changes to the characters and domain.

Shane teaches generating a personal identification code for the contact name. By definition, a personal identification code is unique to every user. The claim would have been obvious because the substitution of a contact name for a personal identification would have yielded predictable results to one of ordinary skill in the art at the time of the invention.

Nonetheless, Examiner takes official notice that making changes to the characters or domain to make a URL unique is well known in the art. It would have been obvious to a person having ordinary skill in the art to make the resource location description unique by modifying the characters and the domain in order to ensure that the variety of promotions are recipient specific thus ensuring creativity in the targeted advertising. Therefor the claimed limitations would have been obvious modification to the combined system of Shane and LeMole.

Response to issue 3: Appellant's argument that the Examiner erred in rejecting claims 45-53 and 62-63 under 35 U.S.C. 101 as directed to non-statutory subject matter.

To be statutory, a claimed computer-related process must either: (A) result in a physical transformation outside the computer for which a practical application is either disclosed in the

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specification or would have been known to a skilled artisan, or (B) be limited to a practical application with useful, concrete and tangible result.

In view of Applicant's disclosure, specification page 18, line 10, the "computer readable medium" is not limited to tangible embodiments, instead being defined as including both tangible embodiments (e.g., RAM, ROM, CD-ROM, disks, etc.) and intangible embodiments (e.g., carrier waves). These claims are not patent eligible because it lacks necessary physical articles or objects to constitute a machine or a manufacture within the meaning of 35 U.S.C 101. It is clearly not a series of steps or acts to be a process nor is it a combination of chemical compounds to be a composition of matter. As such, these claims fail to fall within a statutory category. It is, at best, functional description material per se.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

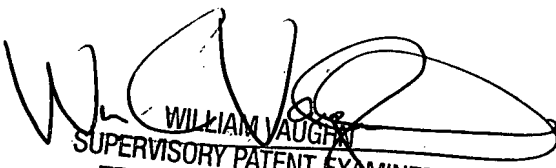
For the above reasons, it is believed that the rejections should be sustained.

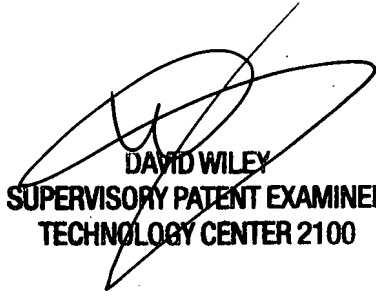
Respectfully submitted,

ANB

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